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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/690,300

10/21/2003

Keisuke Miura

17135

6905

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EXAMINER

VRETTAKOS, PETER J

ART UNIT

PAPER NUMBER

3739

MAIL DATE

DELIVERY MODE

09/19/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/690,300	<b>Applicant(s)</b> MIURA, KEISUKE	
	<b>Examiner</b> Peter J. Vrettakos	<b>Art Unit</b> 3739	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 16 August 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 2-6 and 8-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 2-6 and 8-17 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

Finality is withdrawn in light of the Amendment dated 8-16-07.

Claims 2-6 and 8-17 are subject to the below restriction requirement.

Note: Patent Rules § 1.142 Requirement for restriction: (a) If two or more independent and distinct inventions are claimed in a single application, the examiner in an Office action will require the applicant in the reply to that action to elect an invention to which the claims will be restricted, this official action being called a requirement for restriction (also known as a requirement for division). Such requirement will normally be made before any action on the merits; however, it may be made at any time before final action.

There are currently **seven** independent claims. In at least one of each of the independent claims are the following elements: a heater; tool(s); heat setting device; memory device; table reading device; driving circuit; identifying device; judging device; connector receiving section; initial characteristics measuring device; ambient temperature measurement device; resistance value detection device; temperature correction device; power supply device; control section; and an operating device.

Although each of the seven independent claims refer to the Applicant's invention (includes at least four separate embodiments), each of those claims create numerous interpretations for which the Examiner is obligated to consider. (In each of the claims, the Applicant picks and chooses to claim different "devices" from the Applicant's invention resulting in interpretations of different inventions.) These interpretations would make **examination** burdensome warranting the following restriction requirement.

(MPEP § 803 reads: [i]f the search and **examination** of all the claims in an application can be made without serious burden, the examiner must examine them on the merits, even though they include claims to independent or distinct inventions. As such, if **examination** of an application's claims rises to the level of "burdensome", then restriction is proper.)

Note that the prior Office statement 3-9-07 that claims 11, 15 and 17 are allowable was **conditional**.

The application appears to be a direct translation from a Japanese patent application. This results in an application very difficult to understand including claims replete with functional language not well described or even found in the specification. (Ex.: Does the identifying *device* in the claims correspond to the identifying *section* in the specification?) Examination is further clouded by the choice to describe "devices" in the claims by their functions instead of their actual physical structure.

Allowance of each of the independent claims would result in seven independent and distinct patented inventions. This would run counter to the suggestions of 35 USC § 121: If two or more independent and distinct inventions are claimed in one application, the Director may require the application to be restricted to one of the inventions. (The Office considers each of the Applicant's seven independent claims an independent and distinct invention.)

In order to make progress on this application and to avoid indefiniteness rejections, the Applicant should elect one independent claim and explain each claimed

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element specifically referring to excerpts in the specification, and when possible referring to claim language actually in the specification.

The Applicant should file new claims correcting all typographical errors found in the claim set dated 8-16-07. Example: “**a-heating** setting device”.

### ***Election/Restrictions***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

#### **Group I**

Claim 2 Heat treatment apparatus with a table reading device, classified in class 606, subclass 27.

#### **Group II**

Claim 3 Heat treatment apparatus with an ambient temperature measuring device and initial characteristics measurement device, classified in class 606, subclass 27.

#### **Group III**

Claims 4-6 Heat treatment apparatus with a plurality of treatment tools, an initial characteristics measurement device and a driving device, classified in class 606, subclass 27.

#### **Group IV**

Claims 8-10 Heat treatment apparatus with a plurality of treatment tools, an initial characteristics measurement device, a driving device and a control section, classified in class 606, subclass 27.

#### **Group V**

Claims 11-14 Heat treatment apparatus with an identifying device and judging device, classified in class 606, subclass 27.

#### **Group VI**

Claims 15-16 Heat treatment apparatus with a judging device, operating device and a memory device, classified in class 606, subclass 27.

#### **Group VII**

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Claim 17 Heat treatment apparatus with an ambient temperature measuring device, a temperature correcting device and a treatment tool, classified in class 606, subclass 27.

Each of the seven groups describe a system comprising devices that perform different functions as a result of their differing devices in each of the groups.

The inventions are distinct, each from the other because of the following reasons:

Inventions I-IV are directed to related electrosurgical systems. The related inventions are distinct if the (1) the inventions as claimed are either not capable of use together or can have a materially different design, mode of operation, function, or effect; (2) the inventions do not overlap in scope, i.e., are mutually exclusive; and (3) the inventions as claimed are not obvious variants. See MPEP § 806.05(j). In the instant case, each of the seven inventions/groups as claimed describe a system comprising "devices" that perform different functions. Furthermore, the inventions as claimed do not encompass overlapping subject matter and there is nothing of record to show them to be obvious variants.

Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required because the inventions have acquired a separate status in the art due to their recognized divergent subject matter (articulated above), restriction for examination purposes as indicated is proper.

A telephone call was made to Seth Weinfeld on 9-11-07 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Should applicant traverse on the ground that the inventions or species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions or species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C.103(a) of the other invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

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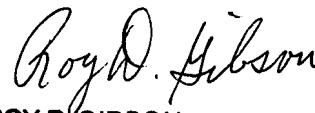
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter J. Vrettakos whose telephone number is 571-272-4775. The examiner can normally be reached on M-F 9-6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C. Dvorak can be reached on 571-272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Pete Vrettakos  
September 11, 2007



ROY D. GIBSON  
PRIMARY EXAMINER